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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/175,589

Applicant(s)

JACOBSON, ANDREA M.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-22 are pending. Claims 1, 10, 13, and 17 have been amended in this communication filed 03/21/03 entered as Amendment D, paper no. 20.
2. The Advisory Action of 04/08/03 has been entered as paper no. 21.
3. The Extension of Time (5 months) filed 06/30/03 has been entered as paper no. 22.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/30/03 has been entered as paper no. 23.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 13, and 17 including dependent claims 2-12, 14-16, and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not find in Applicants' Specification or drawings "a minimum time period based on a pre-determined retention policy" as claimed in independent claims 1, 13, and 17. It is unclear to the Examiner from reading the

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Specification and viewing the drawings what Applicants' mean by "a predetermined retention policy." Applicants' are respectfully requested to clarify and to point out the limitation ""a minimum time period based on a pre-determined retention policy" to the Examiner and in the Specification and drawings.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,108,688) Nielsen in view of (US 5,245,532) Mourier.

With respect to claim 1, Nielsen teaches, creating an electronic tag that uniquely identifies the electronic record, the tag having at least one field for characterizing the record (col. 2, lines 5-30); sending the electronic record to a recipient (col. 2, lines 57-66) wherein; at least one of the steps of creating and storing ensure maintenance of the characterized record for a minimum time period based on a pre-determined retention policy (col. 3, lines 8-26); and the recipient will be unable to delete the record from the central repository prior to the end of the minimum time period established by the predetermined retention policy(col. 4, lines 32-45).

Nielsen did not teach, storing the at least one electronic tag in a central repository.

Mourier discloses, storing the at least one electronic tag in a central repository (col. 4, lines 12-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the at least one electronic tag in a central repository and to modify in Nielsen because such a modification would allow Nielsen to file the tag in a first storage(central repository) means or "Mail To Be Answered" file.

With respect to claim 2, Nielsen did not teach, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier discloses, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to purge the electronic record comprising the steps of deleting the electronic record and selectively deleting the at least one electronic tag and to modify in Nielsen because such a modification would allow Nielsen to have the tag transferred into the "To Be Answered" file and deleted from the "To Be Assigned" file (purging the electronic record comprising the steps of deleting the electronic record).

With respect to claim 3, Nielsen teaches, the step of storing the electronic record (col. 5, lines 24-34).

With respect to claim 4, Nielsen teaches, the sending step further comprises the step of selectively determining whether the recipient may purge the electronic mail (col. 6, lines 43-50).

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

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With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

9. Claims 5-12, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Mourier and further in view of (US 5,786,817) Sakano et al, hereafter Sakano.

With respect to claim 5, Nielsen and Mourier did not teach, analyzing a network user's workstation specifications and the electronic tag being generated from information analyzed in the at least one of the network user's workstation, the network user's user profile, and the reference code.

Mourier discloses, analyzing a network user's user profile (col. 5, lines 26-45); generating a reference code (col. 2, lines 61-64); and a network user's user profile, (col. 2, lines 58-68 and col. 3, lines 1-2).

Sakano discloses, analyzing a network user's workstation specifications (col. 2, lines 15-35), analyzing a network user's profile (col. 4, lines 12-16), and wherein the electronic tag is generated from information analyzed in the at least one of the network user's workstation, the network user's user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to analyze a network user's workstation specifications and wherein the electronic tag is generated from information analyzed in the at least one network user's workstation, the network user's user profile, and the reference code and to

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combine Nielsen's creating an electronic tag that uniquely identifies the electronic record and Mourier's network user's user profile, reference code, and electronic tag with Sakano's analyzing a network user's workstation specifications and the electronic tag being generated from information analyzed in the at least one network user's workstation, the network user's user profile, and the reference code because such a combination would allow Nielsen and Mourier and Sakano's systems to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, Nielsen did not teach, reading the stored electronic tags and generating a further electronic tag in response to accessing an electronic record. Mourier discloses, reading the stored electronic tags and generating a further electronic tag in response to accessing an electronic record (col. 4, lines 18-36). Sakano discloses reading the stored electronic tags and generating a further electronic tag in response to accessing an electronic record (col. 4, lines 9-16). Together Mourier and Sakano teach the claim limitations of claim 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to read the stored electronic tags and generating a further electronic tag in response to accessing an electronic record and to modify in Nielsen because such a modification would allow Nielsen to have a special memory section within his machine, memory section he may access on a read/write basis.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.



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With respect to claim 8, Nielsen did not teach, a classification code and an index code. Mourier discloses a classification code and an index code (col. 4, lines 49-68, col. 5, lines 1-6, and col. 8, lines 24-34). Sakano discloses a classification code and an index code (col. 4, lines 35-65). Together Mourier and Sakano teach the claim limitations of claim 8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a classification code and an index code and to modify in Nielsen because such a modification would allow Nielsen to have a command that sorts (index) the files by updated dates (index code).

With respect to claim 9, Nielsen teaches, business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. Col. 1, lines 7-41). Mourier discloses business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 7, lines 7-16). Sakano discloses business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 4, lines 9-16).

The nature of E-mail does not entitle any patentable weight. The nature of the E-mail is a design choice.

With respect to claim 10, Nielsen did not teach, the index code identifies the contents of the electronic record and the sender or recipient of the electronic record.

Mourier discloses, the index code identifies the contents of the electronic record and the sender or recipient of the electronic record (col. 7, lines 35-41). Sakano discloses the index code identifies the contents of the electronic record and the sender or recipient of the electronic record (col. 4, lines 1-16). Together Mourier and Sakano teach the claim limitations of claim 10. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to have the index code identifies the contents of the electronic record and the sender or recipient of the electronic record and to modify in Nielsen because such a modification would allow Nielsen to have a subject and to have a message with the sender code (86156LAG0192 –as shown in col. 7 and 8, lines 59-68) and recipient code (86156LAG0200-as shown in col. 7 and 8, lines 59-68).

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,245,532) Mourier in view of (US 6,108,688) Nielsen.

With respect to claim 13, Mourier teaches, a computer system comprising at least one processor processor (col. 2, lines 26-32) and at least one memory (col. 3, lines 20-22).

Nielsen teaches, creating an electronic tag that uniquely identifies the electronic record, the tag having at least one field for characterizing the record (col. 2, lines 5-30); sending the electronic record to a recipient (col. 2, lines 57-66) wherein; at least one of the steps of creating and storing ensure maintenance of the characterized record for a minimum time period based on a pre-determined retention policy (col. 3, lines 8-26); and the recipient will be unable to delete the record from the central repository prior to the end of the minimum time period established by the predetermined retention policy(col. 4, lines 32-45).

Nielsen did not teach, storing the at least one electronic tag in a central repository.

Mourier discloses, storing the at least one electronic tag in a central repository (col. 4, lines 12-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the at least one electronic tag in a central repository and to modify in Nielsen because such a modification would allow Nielsen to file the tag in a first storage(central repository) means or "Mail To Be Answered" file.

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***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Discolo et al (US 6,370,566 B2) discloses electronic mail with an identification tag.

***Inquiries***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
E. Colbert

September 21, 2003